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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
LONSDERRY, HUNTER B				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/733,332

**Applicant(s)**

YAMADA ET AL.

**Examiner**

Hunter B. Lonsberry

**Art Unit**

2421

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-10, 12-20 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 12-20 and 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 11/18/09 have been fully considered but they are not persuasive.

Applicant argues that the combination of Srinivasan and Alexander fails to disclose "at the view apparatus, processing software stored in a data storage medium" and "the step of outputting an operation signal.... without requiring any transmission to the transmitter". (Page 2) Srinivasan's VOD request to a cable company does not constitute processing software stored in a data storage medium at the viewer apparatus; further transmitting the VOD request constitutes a transmission to a transmitter. (Page 3) Alexander is only relied upon to teach performing a processing step without requiring any transmission to the transmitter; however the combined teachings of Alexander with Srinivasan require a transmission to a transmitter. While Alexander may teach customized advertising messages can be preloaded by zip code, storing ads at the viewer's terminal does not obviate the requirement for Srinivasan to send VOD requests back to the cable company in order to receive VOD programming. (Page 4).

The Examiner respectfully disagrees. The claims merely require at the "viewer apparatus..... without requiring any transmission to the transmitter". That is several steps occur at the viewer apparatus which do not require any transmission to the

transmitter. The processing steps at the viewer apparatus occur after any TV content data, command data and complementary data has already been received at the viewer apparatus. Further given the open ended comprising language, the VOD request could occur at anytime, but if VOD content is to be transmitted to the user (and the VOD content comprises the above data), then the VOD request has to occur prior to the content being delivered to the viewer apparatus. The combination of Srinivasan with Alexander results in a system in which all of the processing steps occur without requiring any transmission to the transmitter and teaches each and every element of claim 1.

Applicant argues there is not motivation to combine Srinivasan and Alexander because such a combination would produce an inoperative device. Srinivasan teaches that the annotation and video streams are separate, but if the two streams were generated at two separate locations, "without requiring any transmission from one location to the other" the Srinivasan would not be capable of giving the separate video stream and annotation stream frame specific identification and marking so that the streams can be synchronized. (Pages 4-5).

The Examiner respectfully disagrees. The claims merely require at the "viewer apparatus..... without requiring any transmission to the transmitter". That is several steps occur at the viewer apparatus which do not require any transmission to the transmitter. The processing steps at the viewer apparatus occur after any TV content

data, command data and complementary data has already been received at the viewer apparatus. Further given the open ended comprising language, the VOD request could occur at anytime, but if VOD content is to be transmitted to the user (and the VOD content comprises the above data), then the VOD request has to occur prior to the content being delivered to the viewer apparatus, where the content itself is processed. The combination of Srinivasan with Alexander results in a system in which all of the processing steps occur without requiring any transmission to the transmitter and teaches each and every element of claim 1.

Further the Examiner notes that Srinivasan's system, when modified by Alexander would still be capable of giving the video stream 53 and annotation stream 55 frame specific identification and marking such that these streams could be later synchronized as Alexander's teachings do not effect these steps, in that return transmission is not required for synchronization, when the synchronization of content is performed locally.

Lastly, the Examiner has provided motivation to combine the references.

*Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Srinivasan to utilize the zipcode matching, targeted advertising, and content seeking features as taught by Alexander for the advantages of providing advertisements which are geographically relevant, and match the users ongoing interests and provide the user with other content which is of most interest to a user.*

The Examiner has failed to provide any reasoning one of ordinary skill in the art would modify Srinivasan and Alexander to obtain all of the elements (pages 5-6).

As presented in the last Office Action, the Examiner concluded: *Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Srinivasan to utilize the zipcode matching, targeted advertising, and content seeking features as taught by Alexander for the advantages of providing advertisements which are geographically relevant, and match the users ongoing interests and provide the user with other content which is of most interest to a user.*

That is to say, Alexander's teachings would provide additionally flexibility to a user in terms of types of content available to the user, additionally by preloading some of the complementary content, in situations where the content could not otherwise be retrieved at the same time as the other data (a server is slow due to latency issues, or can not be reached).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-10, 12, 14-15, 19-28 and 30-33 rejected under 35 U.S.C. 103(a) as being unpatentable over are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan (US 6457042), in view of U.S. 6,177,931 to Alexander.

As to claim 1, note the Srinivasan reference which discloses a data transmission method. The claimed broadcasting from a transmitter to a viewer apparatus first data containing television content data, command data and complementary data provided for signal processing at a viewer end is met by the video sequence data, the video parameters data, and the personalized data, which are transmitted from the video server 45 to the local "set-top" box 48a(STB) (figures 7, column 13, lines 3-145), also the video services may include broadcasting of standard TV programs over the internet, through cable systems or via satellite (column 13, lines 5-8),. The claimed receiving said the TV content data, command data and complementary data at said viewer end is met by the STB 48a receiving all of the data as described above (column 13, line). The claimed "outputting an operation signal based on said operation" is met by a user's requested video (column 33, lines 21-23). The claimed "performing a first signal processing on said television content data according to software stored in a data storage medium and said operation signal to output first output content data", is met by the end user device 115 (column 21, line 5-column 22, line 9, column 7, line 55-column 8, line 37, figures 2-4)

The claimed " incorporating the complementary data using said first output content data and said television content data according to commands said command

data to generate second output content data; and outputting the second output content data" is met by end user device 115 (column 21, line 5-column 22, line 9, column 7, line 55-column 8, line 37, figures 2-4). The claimed outputting the second output content data is met by a monitor (column 22, lines 1-3).

Srinivasan however fails to disclose performing the possessing steps without requiring any transmission to the transmitter.

Alexander discloses a targeted advertising system which overlays video data by packet matching overlay data specified for a specific zipcode, and a user, upon initial startup of the device may input the zipcode, likewise advertisements may be narrowcast customized messages (column 32, lines 7-21, 35-60), all the users viewing habits may be monitored locally and targeted ads may be stored locally, the monitoring enabling targeted ads based off users interests and viewing history to provide the most appropriate ads as well as additional content which matches a users interest (column 29, lines 14-column 30, line 44, column 31, lines 48-61, column 34, lines 10-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Srinivasan to utilize the zipcode matching, targeted advertising, and content seeking features as taught by Alexander for the advantages of providing advertisements which are geographically relevant, and match the users ongoing interests and provide the user with other content which is of most interest to a user.



As to claim 4, Srinivasan further discloses the claimed said viewer end combines said first output content data and said television content data to generate second output content data. Namely an icon is overlaid over a tracked object and a user may click on the icon for additional information. See column 22, lines 1-9).

As to claim 6, Srinivasan further discloses the claimed said first data contains advertisement data as one or both of said television content data and auxiliary data and said viewer end combines said first output content data and said advertisement data to generate and output content data as met by the data that is transmitted to the user computer as described above may comprise advertisement data (column 17, lines 25-28).

As to claim 7, Srinivasan further discloses the claimed said first data contains a plurality of said advertisement data and said viewer end selectively combines one or more of any of said plurality of advertisement data with said output content data as met by the data provided to the mixer (column 17, lines 25-28).

Further Alexander discloses multiple sets of advertising data.

As to claim 8, Srinivasan further discloses the claimed transmitting second data from said viewer end to a transmitting end and generating second television content data for transmission based on said second data at the transmitting end as met by user

input being transmitted upstream for more information in response to selecting an icon.  
See column 22, lines 1-9.

As to claim 9, Srinivasan further discloses the claimed said first data contains command data for controlling said first signal processing at the viewer end, said first signal processing is controlled at said viewer end based on commands contained in said first data, and said second output content data is generated based on content data of a result of said controlled first signal processing is met by the user's input/viewer profile information that is sent to the video server as previously described above.

As to claim 10, see claim 1.

As to claim 12, Srinivasan further discloses the claimed said each viewer apparatus further includes a transmitting means for transmitting desired data to said transmitter and said transmitter prepares said television content data for broadcast based on said desired data as met by user input being transmitted upstream for more information in response to selecting an icon. See column 22, lines 1-9.

As to claim 14, Srinivasan further discloses the claimed said first data contains advertisement data as one or both of said television content data and auxiliary data and said second signal processing means of said viewer apparatus combines first output content data and advertisement data to generate and output fourth output content data

as met by the data that is transmitted to the user computer as described above may comprise advertisement data (column 17, lines 25-28).

As to claim 15, Srinivasan further discloses the claimed said first data contains a plurality of advertisement data and said second signal processing means of said viewer apparatus selectively combines advertisement data with the video data. See column 17, lines 25-28.

Srinivasan does not disclose a plurality of advertisement data which is combined with the video data.

Alexander discloses a plurality of advertisements which may be provided to a user based on profile data, thereby matching ads with viewers who would be most interested in the ads Alexander discloses a targeted advertising system which overlays video data by packet matching overlay data specified for a specific zipcode, and a user, upon initial startup of the device may input the zipcode, likewise advertisements may be narrowcast customized messages (column 32, lines 7-21, 35-60), all the users viewing habits may be monitored locally and targeted ads may be stored locally, the monitoring enabling targeted ads based off users interests and viewing history to provide the most appropriate ads as well as additional content which matches a users interest (column 29, lines 14-column 30, line 44, column 31, lines 48-61, column 34, lines 10-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Srinivasan to utilize the zipcode matching, targeted advertising, and content seeking features as taught by Alexander for the advantages of

providing advertisements which are geographically relevant, and match the users ongoing interests and provide the user with other content which is of most interest to a user.

Regarding claims 19-20, 22, see claim 1.

As to claim 23, see claim 8.

As to claim 24, Srinivasan further discloses the claimed data transmitter...wherein said data generating means generates said first data containing program data containing video data and information for replacing a predetermined object in said video data with another object as met by the swimsuit overlay (column 7, line 55-column 8, line 37, figures 2-4).

As to claim 25, Srinivasan further discloses the claimed data transmitter...wherein said data generating means has one or more advertisement data of a form for viewing combined with any video data as one or both of said television content data and auxiliary data as met by the objects as previously described above may comprise an advertisement (column 7, line 55-column 8, line 37, figures 2-4).

Regarding claim 26, see claim 1.

As to claim 27, Srinivasan further discloses the claimed signal processor...wherein one or both of said first signal processing means and said second signal processing means controls processing based on command data contained in said auxiliary data of said first data as met by column 21, line 5-column 22, line 9.

As to claim 28, Srinivasan further discloses the claimed said second signal processing means combines video data of said first output content data with a predetermined region of video data of said television content data to generate output content data containing new video data as met by column 21, line 5-column 22, line 9.

As to claim 30, Srinivasan further discloses the claimed said second signal processing means combines video data of said television content data with a predetermined region of video data of said first output content data to generate output content data as met by column 21, line 5-column 22, line 9.

As to claim 31, Srinivasan further discloses the claimed said second signal processing means combines said fifth output content data and advertisement data contained in said first data to generate output content data as met column 21, line 5-column 22, line 9, column 17, lines 25-28.

As to claim 32, Srinivasan further discloses the claimed said second signal processing means combines selectively advertisement data contained in said first data

with said sixth content data as met column 21, line 5-column 22, line 9, column 17, lines 25-28.

Alexander is relied upon to teach a plurality of advertising data.

As to claim 33, Srinivasan further discloses the claimed transmitting means for transmitting desired data to a source of transmission of said first data as met by column 22, lines 1-9.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan (US 6,357,042), in view of U.S. 6,177,931 to Alexander, in view of Carr (US 2003/0133043), previously cited by the Examiner.

As to claim 16, see the discussion of claim 1.

Srinivasan /Alexander does not explicitly disclose performing desired signal processing on said television content data according to software stored in a removable recording medium.

However, the Carr reference (US 2003/0133043), specifically teaches that receivers 16, which may include set-top boxes, personal computers, or other types of systems (¶ [0014]), may use software stored in a removable recording medium as stated below:

Various software or firmware (formed of modules, routines, or other layers, for example)

may be stored or otherwise tangibly embodied in one or more machine-readable storage media in the information delivery system. Storage media suitable for tangibly embodying software and firmware instructions may include different forms of memory including~ semiconductor memory devices such as dynamic or static random access memories, erasable and programmable read-only memories (EPROMs), electrically erasable and programmable read- only memories (EEPROMs), and flash memories; magnetic disks such as fixed, floppy and removable disks; other magnetic media including tape; and optical media such as CD or DVD disks. The instructions stored in the one or more storage media when executed cause the information delivery system to perform programmed acts (see ¶ [0052]).

Therefore, it would have been obvious to have combined the Srinivasan and Alexander reference with the Carr references which teaches that television set-top boxes (STBs) and/or computer systems which have television broadcast reception capabilities may have software stored in a removable recording medium, such as a disk (including a CD-ROM or DVD), a memory card or other removable recoding medium for the advantage of providing increased flexibility and expandability, including the capability of making software changes or providing new or additional software upgrades. One of ordinary skill in the art would have been led to have performed a first signal processing on the television content data according to software stored in a removable recording medium for the advantages given above.

As to claim 17, Srinivasan further discloses the claimed said television content data contained in said first data is data relating to an advertisement and said signal combining means of said viewer apparatus combines video data relating to said advertisement with a predetermined region of video data of said processed television content data to generate said output content data containing new video data as met by the data that is transmitted to the user computer/STB, as described above, may comprise advertisement data see column 21, line 5-column 22, line 9, column 17, lines 25-28.

As to claim 18, Srinivasan further discloses the claimed said first data contains a plurality of advertisement data and said signal combining means of said each viewer apparatus selectively combines advertisement data with said output content data as met by column 21, line 5-column 22, line 9, column 17, lines 25-28.

Alexander is relied upon to teach a plurality of advertising data.

Claims 5, 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan (US 6,357,042), in view of Alexander (5,177,931), in further view of Sitrick (USPN 6,425,825), all cited by the Examiner.

As to claim 5, the Srinivasan reference discloses the claimed data transmission method as described in claim 4 above. However, the Srinivasan reference does not explicitly disclose that the first output content data at the viewer end contains data of



any game character and said viewer end replaces video data of a predetermined object contained in said first data with data of the game character of said first output content data to generated sixth output content data.

The Sitrick reference teaches a system and methodology where replacement predefined character images and existing game display functions, including user visual images such as, a "newscaster", a "cameo guest", or a "synthetic actor" with predetermined actions, may be utilized in association with predefined game character and game display functions (col. 13, lines 35-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of the combination of Srinivasan and Alexander, which teaches a data transmission method for replacing objects such as advertisement images in the output received by a user, with the additional teachings of the Sitrick reference which teaches the features of replacing a predefined object with a game character for the advantage of allowing a user to interactively select various types of game characters for use in their game system.

One of ordinary skill in the art would have been led to make such a modification for the advantages given above specifically for use with an interactive television/computer game system.

As to claim 13, the claim is rejected based on similar grounds as the rejection of claim 5 above.

As to claim 29, the claim is rejected based on similar grounds as the rejection of claim 5 above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is (571)272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hunter B. Lonsberry/  
Primary Examiner  
Art Unit 2421

HBL